

REMARKS

35 U.S.C. § 103 Claim Rejections

The Examiner has rejected claims 1, 5-6, 10-11, 14, 17, 21-22, 26-27 and 30 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah ("Consultant in a Box") in view of Englemen et al. (U.S. Patent Pub. No. 2003/0163357). The Examiner has also rejected claims 2, 9, 18 and 25 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of Official Notice. The Examiner has also rejected claims 3 and 19 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of Official Notice and further in view of Peters et al. (U.S. Patent Pub. No. 2003/0088489). The Examiner has also rejected claims 4 and 20 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of Official Notice and further in view of De Goeij (U.S. Patent Pub. No. 2003/0110070). The Examiner has also rejected claims 7 and 23 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of BusinessWire ("Pacific Softworks Announces Investment and Strategic Alliance with Redflag Inc."). The Examiner has also rejected claims 15 and 31 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of Official Notice and further in view of BusinessWire. The Examiner has also rejected claims 8 and 24 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of Lostis et al. (U.S. Patent Pub. No. 2002/0026429). The Examiner has also rejected claims 12-13, 16, 28-29, 32 as being unpatentable under 35 U.S.C. § 103(a) over Cavanah in view of Englemen et al. further in view of Official Notice, further in view of Peters et al., and further in view of De Goeij.

Applicants have carefully considered the Examiner's comments. In response, Applicants have amended claims 1, 8 and 17 and have cancelled claims 2-7, 9-16 and 18-32. Applicants have also added claim 33. As a result, claims 1, 8, 17 and 33 are now pending in the application. It is respectfully submitted that the prior art of record does not disclose all of the limitations of Applicants' amended claims. Moreover, there is no apparent reason to combine the prior art to achieve Applicants' claimed inventions.

Amended claims 1 and 17 require numerous limitations that are not disclosed or suggested by the prior art of record in the manner claimed by Applicants. In order to assist the examiner in reviewing each of the claim limitations of amended claims 1 and 17, Applicants have reproduced the claim language for claims 1 and 17 below. Individual claim limitations have been separately identified and citations to Applicants' specification have been provided to show where exemplary support may be found for each claim limitation.

Accordingly, claim 1 requires a computer-based method for evaluating portfolio management, comprising:

- (1) interviewing a portfolio management industry expert thereby collecting (e.g., 70, Fig. 2; ¶ [0023]):
- (2) a weighting determined by said industry expert for (e.g., 194, 196, Figs. 9B-9C; ¶ [0030])
- (3) each of a plurality of evaluation categories (e.g., 110, 112, Fig. 4; ¶ [0030])
- (4) before asking evaluation questions associated with said evaluation categories (e.g., 172, 176, Fig. 8A; ¶ [0029, 0030, 0032]),
- (5) wherein said evaluation categories comprise categories of (e.g., 114, Fig. 4; ¶ [0025])
- (6) value chain steps (e.g., 110, Fig. 4; ¶ [0025]) and
- (7) performance attributes (e.g., 112, Fig. 4; ¶ [0025]), and
- (8) responses from said industry expert to said evaluation questions (e.g., Figs. 11A-15C; ¶ [0023, 0032, 0036]),
- (9) wherein said evaluation questions comprise groups of questions organized within each of said value chain steps (e.g., 222, Fig. 11A; 240, 242, 244, 246, 248, 250, 252, Figs. 11A-11B; ¶ [0026]) and
- (10) wherein some of said evaluation questions within said value chain steps are directed to said performance attributes (e.g., 248, 250, Fig. 11C; ¶ [0038]) and
- (11) are interspersed across said groups of questions (e.g., 248, 250, Fig. 11C; 336, 322, Fig. 12C; 338, 324, Fig. 13C; 326, 332, Fig. 14C; 340, 328, 334, Fig. 15C; ¶ [0038]);

- (12) inputting said weightings and said responses into a computer analysis tool (e.g., 72, Fig. 2; ¶ [0023]);
- (13) analyzing said responses to said evaluation questions in response to said weightings of said evaluation categories using said computer analysis tool (e.g., 74, Fig. 2; ¶ [0037-0039]); and
- (14) reporting a computer generated analysis to said industry expert (e.g., 76, Fig. 2; ¶ [0023])
- (15) contemporaneously with said interviewing step, said inputting step and said analyzing step (e.g., 106, Fig. 3; ¶ [0023]),
- (16) wherein immediate results are provided to said industry expert (e.g., 178, Fig. 8B; ¶ [0023]) and
- (17) wherein scenarios of said weightings and said responses are immediately comparable (e.g., 78, Fig. 2; ¶ [0023]);
- (18) wherein said computer generated analysis comprises separate analyses for each of (e.g., 142, Fig. 6; 166, Fig. 7; ¶ [0027, 0037-0039])
- (19) said value chain steps (e.g., 144, Fig. 6; ¶ [0037]) and
- (20) said performance attributes (e.g., 146, Fig. 6; ¶ [0038]),
- (21) wherein a value chain analysis is generated for each of said value chain steps comparing (e.g., 270, 274, 278, 282, 286, Fig. 16; ¶ [0037])
- (22) an aggregate of said responses to said evaluation questions within each value chain step (e.g., 241, Fig. 11A; 258, Figs. 11C, 16; ¶ [0037]) to
- (23) the weighting associated with each value chain step that is determined by said industry expert (e.g., 260, Figs. 11C, 16; 194, Fig. 9B; ¶ [0037]), and
- (24) wherein a performance attribute analysis is generated for each of said performance attributes comparing (e.g., 300, 304, 308, Fig. 17; ¶ [0038])
- (25) an aggregate of said responses to said evaluation questions that are interspersed across said groups of questions (e.g., 248, 322, 324, 326, 328, Fig. 17; Fig. 20D; ¶ [0038])
- (26) to the weighting associated with each performance attribute that is determined by said industry expert (e.g., 196, Figs. 9C, 20D; ¶ [0038]),

(27) said interspersed evaluation questions thereby being included in both said value chain analyses and said performance attribute analyses (e.g., 248, Figs. 11B, 11C, 20D; 256, Fig. 16; 248, 300, Fig. 17; ¶ [0037-0038]).

Claim 17 requires a computer-readable medium storing a program, said program directing a computer to analyze an interview and report results by executing the steps comprising:

- (1) receiving a weighting input for each of a plurality of evaluation categories (e.g., 72, Fig. 2; ¶ [0023]),
- (2) said evaluation categories being categories of a portfolio management process and including at least (e.g., 114, Fig. 4; ¶ [0025])
- (3) value chain steps comprising (e.g., 110, Fig. 4; ¶ [0025])
- (4) profile assessment (e.g., 110, Fig. 4; 194, Fig. 9B; ¶ [0025, 0030]),
- (5) asset allocation (e.g., 110, Fig. 4; 194, Fig. 9B; ¶ [0025, 0030]),
- (6) asset selection (e.g., 110, Fig. 4; 194, Fig. 9B; ¶ [0025, 0030]),
- (7) order generation (e.g., 110, Fig. 4; 194, Fig. 9B; ¶ [0025, 0030]), and
- (8) reporting and monitoring (e.g., 110, Fig. 4; 194, Fig. 9B; ¶ [0025, 0030]) and
- (9) performance attributes comprising (e.g., 112, Fig. 4; ¶ [0025])
- (10) automatization (e.g., 112, Fig. 4; 196, Fig. 9C; ¶ [0025, 0030]),
- (11) scalability (e.g., 112, Fig. 4; 196, Fig. 9C; ¶ [0025, 0030]), and
- (12) outsourcing and insourcing (e.g., 112, Fig. 4; 196, Fig. 9C; ¶ [0025, 0030]);
- (13) receiving response inputs to evaluation questions (Figs. 11A-15C; ¶ [0023, 0032, 0036]),
- (14) said evaluation questions being questions about the performance of said portfolio management process (e.g., 176, Fig. 8A; ¶ [0032, 0036]),
- (15) wherein said evaluation questions comprise groups of questions organized within each of said value chain steps (e.g., 222, Fig. 11A; 240, 242, 244, 246, 248, 250, 252, Figs. 11A-11B; ¶ [0026]) and
- (16) wherein some of said evaluation questions within said value chain steps are directed to said performance attributes (e.g., 248, 250, Fig. 11C; ¶ [0038]) and

- (17) are interspersed across said groups of questions (e.g., 248, 250, Fig. 11C; 336, 322, Fig. 12C; 338, 324, Fig. 13C; 326, 332, Fig. 14C; 340, 328, 334, Fig. 15C; ¶ [0038]), and
- (18) wherein predetermined weightings of said evaluation questions are changeable on the same screen display that receives said response inputs (e.g., 234, Fig. 11A; ¶ [0033]);
- (19) analyzing said response inputs to said evaluation questions in response to said weighting inputs of said evaluation categories (e.g., 74, Fig. 2; ¶ [0037-0039]); and
- (20) outputting a plurality of reports based on said analyzing step comprising (e.g., 76, Fig. 2; ¶ [0023])
- (21) an automatic flag for each report identifying levels of improvement potential (e.g., 272, Fig. 16; 302, Fig. 17; 361, Fig. 18; ¶ [0037, 0038, 0040]),
- (22) wherein said report is reviewable contemporaneously with an interview of an industry expert (e.g., 106, Fig. 3; ¶ [0023]),
- (23) thereby providing immediate results to said industry expert (e.g., 178, Fig. 8B; ¶ [0023]) and
- (24) wherein scenarios of said weighting inputs and said response inputs are immediately comparable (e.g., 78, Fig. 2; ¶ [0023]);
- (25) wherein said reports comprise separate reports for each of (e.g., 142, Fig. 6; 166, Fig. 7; ¶ [0027, 0037-0039])
- (26) said value chain steps (e.g., 144, Fig. 6; ¶ [0037]) and
- (27) said performance attributes (e.g., 146, Fig. 6; ¶ [0038]) and
- (28) comprises a value tree report (e.g., 148, Fig. 6; ¶ [0039]);
- (29) said reports for said value chain steps comprise comparing (e.g., 270, 274, 278, 282, 286, Fig. 16; ¶ [0037])
- (30) an aggregate for each value chain report of said response inputs to said evaluation questions within each value chain step to (e.g., 241, Fig. 11A; 258, Figs. 11C, 16; ¶ [0037])
- (31) the weighting input associated with each value chain step (e.g., 260, Figs. 11C, 16; 194, Fig. 9B; ¶ [0037]);

- (32) said reports for said performance attributes comprise comparing (e.g., 300, 304, 308, Fig. 17; ¶ [0038])
- (33) an aggregate for each performance attribute of said response inputs to said evaluation questions that are interspersed across said groups of questions to (e.g., 248, 322, 324, 326, 328, Fig. 17; Fig. 20D; ¶ [0038])
- (34) the weighting input associated with each performance attribute (e.g., 196, Figs. 9C, 20D; ¶ [0038]),
- (35) said interspersed evaluation questions thereby being included in said reports for both said value chain steps and said performance attributes (e.g., 248, Figs. 11B, 11C, 20D; 256, Fig. 16; 248, 300, Fig. 17; ¶ [0037-0038]); and
- (36) said value tree report comprises groupings of some of said response inputs to said evaluation questions from different categories of said evaluation categories into measurement categories (e.g., 402, Fig. 20A; ¶ [0039])
- (37) thereby combining said grouped responses into an effectivity result for each measurement category (e.g., 420, 422, 424, 426, 428, 430, 432, Fig. 20C; ¶ [0040]), and
- (38) comprising a list of key drivers or recommended solutions based on a comparison of said effectivity results and predetermined values for each measurement category (e.g., 370, 372, 374, 376, 378, 380, 382, 384, 386, 388, Figs. 18, 20C ¶ [0041]).

The prior art references cited by the Examiner relate generally to the concepts of financial management and information systems. However, none of the prior art references disclose the specific approach of evaluating portfolio management claimed by Applicants. Applicants' claims as now presented include numerous limitations that are not found or suggested in the prior art. In assessing the patentability of a claim, the Examiner must consider all of the claim limitations. MPEP § 2143.03. It is respectfully submitted that Applicants' claims as now presented are not obvious when all of the claim limitations are considered "as a whole." 35 U.S.C. § 103(a). See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983); *Schenk v. Norton Corp.*, 713 F.2d 782, 785 (Fed. Cir. 1983).

The prior art of record also fails to disclose the additional limitations of dependent claims 8 and 33. Because each of these claims incorporate all of the limitations of allowable claim 1 from which they depend, claims 8 and 33 are also allowable. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983).

Conclusion

In response to the Examiner's comments, Applicants have amended claims 1, 8 and 17 and have cancelled claims 2-7, 9-16 and 18-32. Claims 1, 8, 17 and 33 are pending in the application. It is respectfully submitted that none of the prior art of record discloses all of the limitations of Applicants' claims and there is no suggestion or motivation to combine the prior art to achieve Applicants' claimed inventions. Therefore, Applicants' claims are allowable. Accordingly, Applicants request reconsideration and allowance of the application.

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